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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,065	07/24/2003	Kamaljit S. Paul	29678-1	2221
23482	7590	06/30/2006	EXAMINER	
WILHELM LAW SERVICE, S.C. 100 W LAWRENCE ST THIRD FLOOR APPLETON, WI 54911			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/627,065	PAUL S. KAMALJIT
	<b>Examiner</b>	<b>Art Unit</b>
	Annette R. Reimers	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 April 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 63-90 is/are pending in the application.
- 4a) Of the above claim(s) 85-90 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 63-84 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/02/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Invention I, claims 63-84 in the reply filed on April 17, 2006 is acknowledged. The traversal is on the ground(s) of a non-burdensome search on the examiner. In response to applicant's argument that the search of all the inventions is similar and, thus, the burden on the examiner would not be significant, "a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification" (see M.P.E.P. § 808.02). In the instant case, the inventions have separate classifications. The requirement is still deemed proper and is therefore made FINAL.

Claims 85-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 17, 2006.

***Claim Objections***

Claim 77 is objected to because of the following informalities: Throughout claim 77, which bore is applicant referring to, since applicant claimed a plurality of bores in claim 63. For examination purposes, each bore will be considered to include the structural limitations as set forth in claim 77. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 63-67, 69-71 and 73-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Pohndorf et al. (US Patent Number 5,904,683).

Pohndorf et al. disclose a device comprising a generally rigid arcuate shaped plate, 10, having a top and bottom side, a plurality of bores defined by the plate and passing through the plate from the top side to the bottom side, bone anchors, 32, having a head with a top surface and a shank, a retainer, 44, being positioned within at least one of the bores between the top side and the bottom side of the plate, the retainer having (i) an initial position where at least a first portion of the retainer partially intersects the bore, (ii) a passage position wherein the head of the anchor inserted into the bore has passed the retainer as the anchor is driven to secure the plate to the respective vertebra, and (iii) a retention position where the at least a first portion of the retainer partially intersects the bore and is located proximal to the top surface of the head, wherein the retainer has a closed end portion which is stabilized with respect to the plate and has generally straight portions extending from the closed end and across

at least a portion of the bore (see figures 1 and 11) There are first and second bores relative to their corresponding vertebrae (see figures 1, 7 and 15). The anchor may or may not translate relative to the plate (see figures 8 and 9). The bores comprise recesses, which define a channel for receiving the retainer (see figure 11). When the anchor is in place the retainer is positioned above the top surface of the anchor (see figure 11). The plate includes a shoulder extending into the bore proximate the bottom surface of the plate and defining in part the bore for receiving the shank of the anchor, the shoulder having an arcuate profile, the head of the anchor having a generally bottom surface with an arcuate profile, the shank of the anchor being smaller than the aperture, the head being larger than the portion of the bore at the shoulder, and the arcuate profile of the shoulder being complementary to the arc of the bottom surface of the head, wherein the head of the anchor has a generally arcuate bottom surface, and the bottom surface cams against generally straight portions of the retainer so as to open the retainer from the initial position to the passage position so as to permit the head to pass therethrough (see figure 11).

The retainer position shifts to the retention position after the head is driven past the retainer such that the top surface of the anchor is unable to cam open the generally straight portions of the retainer so as to prevent anchor back-out (see figure 11). In addition, the retainer has a generally upwardly facing surface portion, a generally downwardly facing surface portion, and a generally inwardly facing surface portion, and the anchor head contacts at least one of the surface portions thereby to shift the retainer between the initial position and the retention position (see figures 11-13). The

anchor head cams against at least one of the surface portions of the retainer thereby to shift the retainer between the initial position and the retention position (see figure 11). The retainer follows a continuous path and participates in defining an opening along the bore through which the anchor passes as the anchor secures the plate to the vertebra (see figure 11). In addition, the generally straight portions of the retainer extending between the first and second ends are generally parallel in the initial position (see figure 11).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Pohndorf et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 63-69 and 71-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Bailey et al. (US Patent Publication Number 2002/0151899).

Bailey et al. disclose a device comprising a generally rigid arcuate shaped plate, 12, having a top and bottom side, a plurality of bores defined by the plate and passing through the plate from the top side to the bottom side, bone anchors, 14, having a head

with a top surface and a shank, a retainer, 16, being positioned within at least one of the bores between the top side and the bottom side of the plate, the retainer having (i) an initial position where at least a first portion of the retainer partially intersects the bore, (ii) a passage position wherein the head of the anchor inserted into the bore has passed the retainer as the anchor is driven to secure the plate to the respective vertebra, and (iii) a retention position where the at least a first portion of the retainer partially intersects the bore and is located proximal to the top surface of the head, wherein the retainer has a closed end portion which is stabilized with respect to the plate and has generally straight portions extending from the closed end and across at least a portion of the bore (see figures 1 and 4) There are first, second and third bores relative to their corresponding vertebrae (see figure 6). The anchor may translate relative to the plate (see paragraph 0015). Bailey et al. discloses both elongated and circular bores (see figure 5). The bores comprise recesses, which define a channel for receiving the retainer (see figure 4). When the anchor is in place the retainer is positioned above the top surface of the anchor (see figure 1). The plate includes a shoulder extending into the bore proximate the bottom surface of the plate and defining in part the bore for receiving the shank of the anchor, the shoulder having an arcuate profile, the head of the anchor having a generally bottom surface with an arcuate profile, the shank of the anchor being smaller than the aperture, the head being larger than the portion of the bore at the shoulder, and the arcuate profile of the shoulder being complementary to the arc of the bottom surface of the head, wherein the head of the anchor has a generally arcuate bottom surface, and the bottom surface cams against generally straight portions

of the retainer so as to open the retainer from the initial position to the passage position so as to permit the head to pass therethrough (see figure 4).

The retainer position shifts to the retention position after the head is driven past the retainer such that the top surface of the anchor is unable to cam open the generally straight portions of the retainer so as to prevent anchor back-out (see figures 1 and 4). In addition, the retainer has a generally upwardly facing surface portion, a generally downwardly facing surface portion, and a generally inwardly facing surface portion, and the anchor head contacts at least one of the surface portions thereby to shift the retainer between the initial position and the retention position (see figures 1, 2 and 4). The anchor head cams against at least one of the surface portions of the retainer thereby to shift the retainer between the initial position and the retention position (see figure 4). The retainer follows a continuous path and participates in defining an opening along the bore through which the anchor passes as the anchor secures the plate to the vertebra (see figures 1, 2 and 4). In addition, the generally straight portions of the retainer extending between the first and second ends are generally parallel in the initial position (see figures 1, 2 and 4).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Bailey et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read

on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 63-75 and 77-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkes et al. (US Patent Number 6,679,883).

Hawkes et al. disclose a device comprising a generally rigid arcuate shaped plate, 60, having a top and bottom side, a plurality of bores defined by the plate and passing through the plate from the top side to the bottom side, bone anchors, 70, having a head with a top surface and a shank, a retainer, 64, being positioned within at least one of the bores between the top side and the bottom side of the plate, the retainer having (i) an initial position where at least a first portion of the retainer partially intersects the bore, (ii) a passage position wherein the head of the anchor inserted into the bore has passed the retainer as the anchor is driven to secure the plate to the respective vertebra, and (iii) a retention position where the at least a first portion of the retainer partially intersects the bore and is located proximal to the top surface of the head, wherein the retainer has a closed end portion which is stabilized with respect to the plate and has generally straight portions extending from the closed end and across at least a portion of the bore (see figures 4-6) There are first, second and third bores relative to their corresponding vertebrae (see figures 1 and 8). The anchor may or may not translate relative to the plate (see column 7, lines 30-38). Hawkes et al. discloses both elongated and circular bores (see figures 1 and 8). The bores comprise recesses,

which define a channel for receiving the retainer (see figures 4 and 6). The plate includes a shoulder extending into the bore proximate the bottom surface of the plate and defining in part the bore for receiving the shank of the anchor, the shoulder having an arcuate profile, the head of the anchor having a generally bottom surface with an arcuate profile, the shank of the anchor being smaller than the aperture, the head being larger than the portion of the bore at the shoulder, and the arcuate profile of the shoulder being complementary to the arc of the bottom surface of the head, wherein the head of the anchor has a generally arcuate bottom surface, and the bottom surface cams against generally straight portions of the retainer so as to open the retainer from the initial position to the passage position so as to permit the head to pass therethrough (see figures 4-6).

The retainer position shifts to the retention position after the head is driven past the retainer such that the top surface of the anchor is unable to cam open the generally straight portions of the retainer so as to prevent anchor back-out (see figures 4-6). In addition, the retainer has a generally upwardly facing surface portion, a generally downwardly facing surface portion, and a generally inwardly facing surface portion, and the anchor head contacts at least one of the surface portions thereby to shift the retainer between the initial position and the retention position (see figures 4-6). The anchor head cams against at least one of the surface portions of the retainer thereby to shift the retainer between the initial position and the retention position (see figures 4 and 6). The retainer follows a continuous path and participates in defining an opening along the bore through which the anchor passes as the anchor secures the plate to the

vertebra (see figures 4-6). In addition, the generally straight portions of the retainer extending between the first and second ends are generally parallel in the initial position (see figures 4-6).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hawkes et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER